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LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			CHEN, CHONGSHAN	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/681,183

Applicant(s)

CAPPS, STEPHAN P.

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to Request for Continued Examination filed on 9 July 2004.

This action is non-final.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6, 9, 11, 13, 14, 20, 24-27, 29, 35-38, 40, 41 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443).

As per claim 1, Smiga teaches a system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person; identifying at least one person represented by the identified data (Smiga, col. 5, line 63 – col. 6, line 13, the parser of Smiga parses document, and identifies email addresses enclosed in the document. The email address identifies a person).

Smiga does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is

available; and using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available (Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information. The sub-network connects the computer to the menu catalogue in the search engine. First the catalogue sends a menu regarding what kind of data which is already known, such as ... E-mail-address(es)"); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

The system of Smiga parses a document and identifies email address associated with a person. However, the email address is an incomplete knowledge about the person. It does not tell what is the person's address, telephone number, etc. Thorner discloses a system using already known information about the person, such as email address, to retrieve additional information about the person, and initiating a communication with the person. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the retrieve and communication steps of Thorner in the system of Smiga in order to retrieve additional information associated with the person and communicate with the person.

The retrieved additional information about the person will help the user to identify whether the person is the desired person before initiating communication with the person.

As per claim 4, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein the at least one electronic interface for initiating communication with one or more of the identified persons includes any of an email address, an instant messaging account, a telephone number, a fax number, and an Internet address for communicating with the identified person (Thorner, col. 7, lines 42-55).

As per claim 5, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Smiga, col. 5, line 63 – col. 6, line 47).

As per claim 6, Smiga and Thorner teach all the claimed subject matters as discussed in claim 5, and further teach wherein the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Smiga, col. 5, line 63 – col. 6, line 47).

As per claim 9, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein identifying at least one person represented by the identified data comprises comparing the identified data to information in at least one electronic database to identify each person associated with the identified data (Thorner, col. 4, lines 40-67).

As per claim 11, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein notifying the user that the retrieved information is available

comprises automatically providing a visible alert when the information is retrieved from the at least one electronic database (Thorner, col. 8, lines 15-20).

As per claim 13, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, and further teach the visible alert comprises dynamically modifying the appearance of the electronic document (Smiga, Fig. 3, col. 6, lines 1-13, shadow region).

As per claim 14, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, and further teach wherein dynamically modifying the appearance of the electronic document comprises changing the appearance of the identified data (Smiga, Fig. 3, col. 6, lines 1-48, shadow region).

As per claim 20, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach a graphical user interface for interacting with the retrieved information (Thorner, col. 4, lines 62-67).

As per claim 24, Smiga teaches a computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person; identifying each person represented by the identified information (Smiga, col. 5, line 63 – col. 6, line 13, the parser of Smiga parses document, and identifies email addresses enclosed in the document. The email address identifies a person).

Smiga does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available; using at least a portion of the retrieved information relating to one or

more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available (Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information. The sub-network connects the computer to the menu catalogue in the search engine. First the catalogue sends a menu regarding what kind of data which is already known, such as ... E-mail-address(es)"); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

The system of Smiga parses a document and identifies email address associated with a person. However, the email address is an incomplete knowledge about the person. It does not tell what is the person's address, telephone number, etc. Thorner discloses a system using already known information about the person, such as email address, to retrieve additional information about the person, and initiating a communication with the person. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the retrieve and communication steps of Thorner in the system of Smiga in order to retrieve additional information associated with the person and communicate with the person.

The retrieved additional information about the person will help the user to identify whether the person is the desired person before initiating communication with the person.

As per claim 25, Smiga and Thorner teach all the claimed subject matters as discussed in claim 24, and further teach the user interface provides a user access for viewing the retrieved information (Smiga, Fig. 8).

Claims 26 and 27 are rejected on grounds corresponding to the reasons given above for claims 13 and 14.

As per claim 29, Smiga and Thorner teach all the claimed subject matters as discussed in claim 26, and further teach automatically changing the appearance of graphical information representing the identified information (Smiga, Fig. 3, col. 6, lines 1-148, shadow region).

Claims 35-38, 40, 41 and 50 are rejected on grounds corresponding to the reasons given above for claims 1, 4-6, 9, 11, 13, 14 and 20.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Srinivasan (US 6,717,936).

As per claim 2, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach providing electronic interface (email) for initiating communication with the person. However, neither Smiga nor Thorner explicitly discloses the electronic interface for initiating communication is displayed to a user as an icon. Srinivasan teaches the electronic interface for initiating communication is displayed to a user as an icon (Srinivasan, col. 6, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display an icon representing the communication to the person



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in the system of Thorner because it's conventional practice to display electronic communication (email) as an icon on display for the user to initiate communication with a person.

5. Claims 7, 8 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Dimitrova (US 6,363,380).

As per claim 7, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing parsing an electronic document to identify data representing any person comprises identifying graphical data associated with any person. Dimitrova teaches parsing graphical data to identify person (Dimitrova, col. 12, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the graphical parser of Dimitrova for identifying image in the document processing system of Smiga because a document could comprise graphical data identifying a person. A graphical parser enables the system to parse the graphical data and identify the person.

As per claim 8, Smiga, Thorner and Dimitrova teach all the claimed subject matters as discussed in claim 7, and further teach the graphical data associated with any person includes any image for representing at least one person (Dimitrova, col. 12, lines 1-7).

Claim 39 is rejected on grounds corresponding to the reasons given above for claims 7 and 8.

6. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Sorensen (US 6,628,729).

As per claim 10, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing wherein notifying the user that the retrieved information is available comprises automatically providing an audible alert when the information is retrieved from the at least one electronic database. Sorensen teaches providing an audible alert when information is retrieved (Sorensen, col. 3, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an audible alert in the system of Thorner to warn the user that the retrieved information is available. The audible alert warns the user instantly so that the user can retrieve and read information right away.

Claim 12 is rejected on grounds corresponding to the reasons given above for claims 10 and 11.

7. Claims 15, 28, 30 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Yamakita (US 6,272,490).

As per claim 15, Smiga and Thorner teach all the claimed subject matters as discussed in claim 14, except for explicitly disclosing wherein dynamically modifying the appearance of the electronic document further comprises automatically associating at least one hyperlink with the identified data. Yamakita teaches associating at least one hyperlink with the identified data (Yamakita, col. 1, lines 35-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to associating a hyperlink with the identified data in the document processing system of Smiga. The document processing system of Smiga parses a document and identifies email address in the document. Associating a hyperlink with the email address enables the user to send message to the person directly by just clicking on the hyperlink.

Claims 28, 30 and 42-45 are rejected on grounds corresponding to the reasons given above for claim 15.

8. Claims 16-19, 21-23, 31-34 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Appelman et al. ("Appelman", US 6,539,421).

As per claim 16, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, except for explicitly disclosing the visible alert comprises dynamically adding at least one presence indicator to the electronic document. However, Smiga and Thorner teach using electronic communication (email) to communicate with a person. Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system provides a visible alert that adds presence indicator associated with the person (Appelman, col. 5, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the instant messaging system of Appelman to communicate with the person in the system of Thorner. Because using email system, the message sender will never know when the person will read the email and reply to the email message. However, instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time. It is much faster and efficient way for communication than email.

As per claim 17, Smiga and Thorner teach all the claimed subject matters as discussed in claim 16, except for explicitly disclosing automatically determining an online status for each identified person by querying at least one messaging account server for each identified person. However, Smiga and Thorner teach using electronic communication (email) to communicate

with a person. Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system automatically determines an online status for each identified person by querying at least one messaging account server for each identified person. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the instant messaging system of Appelman to communicate with the person in the system of Thorner. Because using email system, the message sender will never know when the person will read the email and reply to the email message. However, instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time. It is much faster and efficient way for communication than email.

As per claim 18, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 17, and further teach each presence indicator graphically represents the online status of each identified person (Appelman, col. 5, lines 52-55).

As per claim 19, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 18, and further teach using instant messaging system to communicate with the person (Appelman, col. 4, lines 24-30), which inherently includes the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person.

As per claim 21, Smiga and Thorner teach all the claimed subject matters as discussed in claim 20, except for explicitly disclosing the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person. Appelman teaches the graphical user interface comprises at least one pop-up window for displaying the

retrieved information for each identified person (Appelman, Fig. 28-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a pop-up window for displaying the retrieved information in the system of Thorner. Because pop-up window attracts user attention by popping up a window when information is retrieved.

As per claim 22, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 28-29).

As per claim 23, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 5).

Claims 31-34 and 46-49 are rejected on grounds corresponding to the reasons given above for claims 16-19 and 21-23.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 2, 4-50 have been considered but are moot in view of the new ground(s) of rejection.


***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571)272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571)272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CC  
October 15, 2004

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER